

MS APPEAL BRIEF - PATENTS
PATENT
3782-0124P

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION OF

BEFORE THE BOARD OF APPEALS

Appellants: Petter ERICSON et al.

APPEAL NO.:

APPL. NO.: 09/813,112

GROUP: 2179

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EXAMINER: W. HUTTON JR.

FOR: PROCESSING OF DOCUMENTS

REPLY BRIEF UNDER 37 C.F.R. § 41.41

MS APPEAL BRIEF - PATENTS

Commissioner of Patents

January 24, 2007

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Appellants submit herewith a Reply Brief in connection with the appeal of the above-identified application. This Reply Brief responds to the Examiner's Answer dated November 24, 2006.

For clarity, the issues presented in the Appeal Brief filed September 5, 2006, will be repeated, and the reply to the Examiner's Answer will substantially correspond structurally to the argument section in the Appeal Brief.

I. ISSUES ON APPEAL:

The issue to be resolved in this application is:

- 1) Whether claims 1, 6-12, 15, 16, 22, 23 and 31-33 are anticipated under 35 U.S.C. §102(b) based on the teachings of *Lazzouni et al.* (USP 5,652,412) (hereinafter “*Lazzouni*”);
- 2) Whether claims 3, 4 and 18 are unpatentable under 35 U.S.C. § 103(a) as being unpatentable in view of *Lazzouni et al.* in view of *Henderson* (USP 5,897,648) (hereinafter “*Henderson*”);
- 3) Whether claim 13 is unpatentable under 35 U.S.C. § 103(a) based on the teachings of *Lazzouni et al.* in view of *Skinner* (USP 6,661,920) (hereinafter “*Skinner*”);
- 4) Whether claims 2, 17, 19-21, 24-26, 29-30, 34 and 35 are unpatentable under 35 U.S.C. § 103(a) as being unpatentable over *Lazzouni et al.* in view of *Dymetman et al.* (USP 6,752,317) (hereinafter “*Dymetman*”); and
- 5) Whether claim 36 is unpatentable under 35 U.S.C. § 103(a) based on the teachings *Lazzouni et al.* in view of *Dymetman et al.* and further in view of *Henderson*.

II. NEW POINTS OF ARGUMENT RAISED BY EXAMINER’S ANSWER:

Appellants are providing this Reply Brief to respond to new points of argument raised in the Examiner’s Answer. Appellants do not disagree with paragraphs (1)-(8) of the Examiner’s Answer.

The specific new points of argument that are raised in paragraph (10) to which Appellants disagree are as follows:

The Examiner introduces new arguments in support of his rejection of claims 1, 8, 10, 16, 22, 31, 3, 2, 17. Appellants' responses to these new assertions are discussed in paragraphs A. – I., respectively.

III. REPLY:

A. The Rejection Fails to Establish *Prima Facie* Anticipation of Independent Claim 1.

In response to Appellants' arguments that the cited reference fails to anticipate claim 1, namely, "transferring document information to a printing device adapted to print the document information on a surface having a position-coding pattern," and "changing the document information depending on an interpretation of the editing information, thereby resulting in an updated document," the Examiner provides an erroneous interpretation of the statute, and, further misinterprets the teachings of *Lazzouni*.

1. The Examiner is applying the incorrect test to determine whether *Lazzouni* anticipates claim elements

The Examiner asserts that, based upon certain teachings of *Lazzouni*, one of ordinary skill in the art would conclude that the information recording system in *Lazzouni* included a computer printer to which the form was transferred. Appellants respectfully submit that an analysis of what one skilled in the art would conclude is not pertinent in determining whether a prior art document anticipates a claimed invention. In order to properly anticipate Appellant's claimed invention under 35 U.S.C. §102(b), each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. As such, what one skilled

in the art would conclude is wholly irrelevant in determining anticipation under 35 U.S.C. §102. Such an analysis is appropriate for an obviousness rejection under 35 U.S.C. §103.

2. *Lazzouni* fails to teach or suggest “transferring document information to a printing device” as required by claim 1

The Examiner appears to admit that *Lazzouni* fails to expressly teach or suggest “transferring document information to a printing device.” Appellants agree that *Lazzouni* fails to expressly teach this claim element.

In addition, Appellants maintain that it is not inherent that the system of *Lazzouni* teaches this element. It is not inherent that the *Lazzouni* system includes a computer printer for printing forms, that a purported printing device that produces the forms is the same printing device that is communicably linked to a host computer, nor that the purported form information that is purportedly printed on the encoded paper is stored for reprinting within the *Lazzouni* system. It is respectfully submitted that the court in *In re Robertson* held “to establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

First, there is no disclosure that the form information that may be used with the encoded paper is electronic. The Examiner asserts that because *Lazzouni* discloses that the encoded paper “can be made in multisheet pads and can be made as a form or as blank paper,” that one skilled in the art would conclude “that the transfer of the form to the printer is required in order to provide the

encoded forms to a user.” However, this conclusion is not inherent based on the express teachings of *Lazzouni*. It is possible that the form information is handwritten or typed on the paper. Although it may be possible, *arguendo*, that the form is transferred to the printer, the fact that something is possible is insufficient to establish inherency.¹ As such, Appellants maintain that it is not inherent that the form information is electronic nor that electronic form information is transferred to a printer, as asserted by the Examiner.

Second, the purported printing device may not be communicably linked to the system described in *Lazzouni*. In fact, not only is it possible, but it is likely that, should a printing device print the form, the printing device that prints the form is not the printing device that is communicably linked to the system discussed in *Lazzouni*. It is well known that forms are usually ordered from a printing company as the printing company has capacity to print at high speed with higher quality printing, where the computing and printing devices are not communicably linked to consumer devices. As *Lazzouni* fails to inherently teach or suggest any printing device that prints the forms, that the form is actually printed and not generated manually by a user, or that the form information is accessible for reprinting within the *Lazzouni* system, Appellants respectfully submit that the “transferring of document information to a printing device adapted to print the document information on a surface having a position-coding pattern” is not inherent based on the teachings of *Lazzouni*.

¹ See *Continental Can Co. USA, Inc. v. Monsanto*, 20 USPQ2d 1746, 1749, 1750 (Fed. Cir. 1991).

3. *Lazzouni* fails to teach or suggest “changing the document information depending on an interpretation of the editing information, thereby resulting in an updated document,” as required by claim 1

The Examiner asserts, in support of his rejection of “changing the document information depending on an interpretation of the editing information, thereby resulting in an updated document,” in his Examiner’s Answer on page 47, lines 1-7, that *Lazzouni* discloses

That the system provided both a written copy of the recorded sales transactions and an electronic copy of the recorded sales transactions in the memory of the system. The written and electronic copies of the recorded sales transactions included both the encoded form and the handwritten entries made by the salesmen (i.e., the “*document information*”). The edited encoded forms, which included the handwritten entries made by the salesmen, are the equivalent of the “*updated document*” recited in Claim 1.

However, the Examiner assumes that the form information is electronic, that the form information is somehow transmitted to and stored within the *Lazzouni* system, and that the form information is reproduced with the handwritten information. *Lazzouni* does not expressly nor inherently teach these assertions, as discussed above.

In addition, the Examiner has expressed his interpretation of the term “document information” as including both original text and handwritten text. Since it is not expressly nor inherently taught that the form information is stored or accessible within the *Lazzouni* system, the Examiner’s conclusion that the form information is reproduced with the handwritten information is wholly improper for an analysis under 35 U.S.C. §102.

As required by claim 1, the document information, that was transferred to a printing device in an earlier step in the claim, is changed depending on the interpretation of the editing information. There is no reasonable interpretation of *Lazzouni* that teaches or suggests that the form information is reproduced with any handwritten text. As such, Appellants maintain that *Lazzouni* fails to teach or suggest changing the document information, thereby resulting in an updated document.

4. The Examiner's reliance on Appellants' alleged admitted art based on a second reference is wholly improper for an analysis of anticipation under 35 U.S.C. §102

In the Examiner's Answer on page 47, lines 12-16, the Examiner asserts that Appellants admitted certain teachings of *Henderson* (U.S. Patent No. 5,897,648) as prior art. However, Appellants note that the outstanding rejection of claim 1 is made under 35 U.S.C. §102. As noted above, in order to establish anticipation, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference, namely the cited reference of *Lazzouni*. If the Examiner is relying on the teachings of *Henderson* to anticipate claim 1, the Examiner must establish *prima facie* obviousness under 35 U.S.C. §103. As the Examiner has rejected claim 1 asserting anticipation, the Examiner must find all of the claim elements within the cited art, *Lazzouni*. The Examiner's reliance on any teachings of *Henderson* is wholly improper in an analysis of anticipation under 35 U.S.C. §102.

5. The Examiner fails to address Appellants' arguments that *Lazzouni* fails to teach or suggest symbols associated with grid points of a grid.

In response to Appellants' arguments that *Lazzouni* fails to teach or suggest symbols associated with grid points of a grid, the Examiner asserts that Appellants' argument is contradictory. Appellants' respectfully disagree with the Examiner.

At the outset, the teachings of *Lazzouni* clearly depicts a single pixel in Fig. 4. Fig. 4 depicts a plurality of horizontal and vertical delimiter lines and a plurality of horizontal and vertical data lines. The uniqueness of each pixel is established by an algorithm which orders the vertical and horizontal data lines (col. 6, lines 60-65). There is no reasonable interpretation of the term "symbol" that may include the plurality of delimiter lines and data lines within a single pixel of *Lazzouni*, or that the *Lazzouni* pixel itself anticipates the symbol of the present invention. As such, Appellants

maintain that the single pixel depicted in Fig. 4, to which the Examiner relies on, does not anticipate a “symbol” of the present invention.

Further, the Examiner asserts that as *Lazzouni* teaches the pixels are laid out on an X-Y grid, this would anticipate “symbols associated with grid points of grid. However, as *Lazzouni* fails to teach symbols, *Lazzouni* fails to teach or suggest symbols associated with grid points of a grid. Should the Examiner interpret the full set of horizontal and vertical data lines and delimiter lines as one whole symbol, Appellants maintain that this interpretation would still fail to anticipate the claim element, as one symbol cannot anticipate a plurality of symbols.

Still further, as argued in Appellants’ Appeal Brief, the pen path of *Lazzouni* is determined based on X and Y vectors determined by the position of the pen. The position of the *Lazzouni* pen is determined at an instance N, where the Y-axis property and X-axis property are noted. As the *Lazzouni* pen moves over pixels, a series of vectors are produced. However, there is no teaching or suggestion in *Lazzouni* that any symbols are associated with grid points of a grid.

The Examiner provides no new argument contrary to these assertions other than to assume that the pixel of *Lazzouni* teaches a symbol and that a position may be determined based on the ordering of the lines within the pixel. However, for the reasons noted above, and for the reasons set forth in Appellants’ Appeal Brief, *Lazzouni* fails to teach or suggest symbols, and further fails to teach or suggest symbols associated with grid points of a grid.

6. The Examiner misinterprets the teachings of *Lazzouni* in asserting that *Lazzouni* teaches “each position being coded by a plurality of symbols, wherein each symbol contributes to the coding of more than one of the plurality of positions.”

In response to Appellants’ argument that *Lazzouni* fails to teach or suggest “each position being coded by a plurality of symbols, wherein each symbol contributes to the coding of more than

one of the plurality of positions,” the Examiner responds in the Examiner’s Answer starting on page 50, line 11 as follows:

Lazzouni expressly discloses that the information recording system includes pen that must move through a number of vertical and horizontal lines of a pixel before the pixel can be registered and the position of the pen calculated (see Column 12, Lines 30-34). For example, Lazzouni expressly discloses that the pen may move horizontally through several pixels, but its position on the encoded paper could not be calculated until it has also completed traversed a pixel in the vertical direction (See Column 12, Lines 30-34).

That is, depending upon the user’s movement of the pen on the encoded paper, the determination of each position of the pen’s movement path across the encoded paper may require a plurality of pixels. Based on this disclosure, one of ordinary skill in the art at the time the invention was made... would conclude that, in many instances, the determination of each position of the encoded paper requires a plurality of pixels.

However, the Examiner completely misinterprets the teachings of *Lazzouni*. At col. 12, lines 30-34, *Lazzouni* discloses:

The B vector provides the location of the pen with respect to X and Y lines. The pen has to move at least L lines vertically and horizontally before a complete pixel can be registered and the absolute position of the pen calculated. Thus, the pen may move horizontally through several pixels, but it’s position on the paper could not be calculated unless it has also traversed a complete pixel in the vertical direction.

The Examiner interprets these teachings to imply that more than one pixel is needed in order to determine the absolute position of the pixel. But this is a wholly improper interpretation of the teachings of *Lazzouni*. *Lazzouni* clearly teaches that because the horizontal lines extend through a plurality of pixels, and because the vertical lines extend through a plurality of pixels, the system must have moved through a sufficient number of vertical and horizontal lines **within the pixel** in order to determine the position. This does not mean that a plurality of pixels are needed in order to determine the position of one pixel. This simply means that a minimum number of horizontal and vertical data lines **from within one pixel** are needed in order to determine the position of the pixel. In addition, at col. 6, line 60 through col. 7, line 17, *Lazzouni* clearly describes how the information

contained within a single pixel is used to determine the position of the pixel. As such, the Examiner's interpretation that information from a plurality of pixels are needed in order to determine position of one single pixel is wholly improper.

As such, Appellants maintain that *Lazzouni* fails to teach or suggest each position being coded by a plurality of symbols.

In addition, the Examiner further argues that one skilled in the art would conclude certain teachings. However, as noted above, as the outstanding rejection is made under 35 U.S.C. §102, it is wholly improper for the Examiner to rely on what one skilled in the art would appreciate.

Finally, the Examiner fails to address Appellants' argument that *Lazzouni* fails to teach or suggest "wherein each symbol contributes to the coding of more than one position." Appellants rely on the arguments set forth in their Appeal Brief to maintain that *Lazzouni* fails to teach or suggest this claim element.

B. The Rejection Fails to Establish *Prima Facie* Anticipation of Independent Claim 8.

In response to Appellants' argument that *Lazzouni* fails to teach or suggest displaying the document information of the updated document to a user, the Examiner responds in the Examiner's Answer on page 52, starting at line 4 as follows:

Lazzouni expressly discloses that encoded forms of the information recording system were provided to salesmen for the purpose of recording sales transactions and that entries made by the salesmen were stored in the memory of the system (see Column 14, Lines 22-33). Lazzouni expressly discloses that the information recording system provides both a hard copy of the sales transaction and a record in memory (see Column 14, Lines 27-29). Based on this disclosure, one of ordinary skill in the art at the time the invention was made ... would conclude that the system could display the edited sales transaction (i.e., the "updated document") to a user.

Appellants disagree with these assertions.

First, *Lazzouni* discloses that entries made by the salesmen were stored in the memory of the system. However, as noted above, there is no teaching or suggestion in *Lazzouni* that is directed to storing the form information, as assumed by the Examiner. The system of *Lazzouni* merely discloses storing the handwritten information, i.e., the sales transaction, in memory.

Second, the hard copy of the sales transaction is the paper copy that was written on by the user. The record of the transaction is merely the handwritten information stored in the memory. Again, there is no teaching that the form information is stored in the *Lazzouni* system.

As such, since only the handwritten information is stored in the system, and not the form information, it is not inherent that the form and the handwritten information are displayed to a user.

Third, the Examiner concludes that based upon certain teachings, the system **could** display the edited transaction to a user. However, as noted above, the fact that a system could do something is insufficient to establish inherency under 35 U.S.C. §102.²

Fourth, and finally, the Examiner again relies on what one skilled in the art would conclude. However, as the outstanding rejection is asserted under 35 U.S.C. §102, it is wholly improper for the Examiner to rely on what one skilled in the art would conclude.

For all of the reasons set forth above, Appellants maintain that *Lazzouni* fails to teach or suggest the elements as set forth in claim 8.

C. The Rejection Fails to Establish *Prima Facie* Anticipation of Independent Claim 10.

In response to Appellants' arguments that *Lazzouni* fails to teach or suggest "associating, based on position information included in the editing information, each of the handwritten

² See *Continental Can Co. USA, Inc. v. Monsanto*, 20 USPQ.2d 1746, 1749, 1750 (Fed. Cir. 1991).

annotations with a respective portion of the document information,” the Examiner responds in the Examiner’s Answer on page 53, lines 6-19 as follows:

Lazzouni expressly discloses that encoded forms of the information recording system were provided to salesmen for the purpose of recording sales transaction and that entries made by the salesmen were stored in the memory of the system...Lazzouni also expressly discloses that, when the pen is used to write on the encoded paper, the positions of the pen tip path are determined by reading the pixel pattern on the encoded paper and these positions are stored in the information recording system, thereby providing an electronic representation of the written record on the encoded paper.

Based on this disclosure, one of ordinary skill in the art at the time the invention was made ... would conclude that each handwritten entry (i.e., “each of the handwritten annotations”) is located (i.e., associated, based on position included in the editing information”) in the proper position on the encoded form (i.e., with a respective portion of the document information).

Appellants respectfully disagree with the Examiner’s assertions.

First, as noted above, *Lazzouni* merely discloses that the entries made by the salesmen were stored in the memory of the system. As noted above, there is no disclosure that the form information is ever stored within the *Lazzouni* system.

Second, *Lazzouni* merely teaches that an electronic record of the written record is provided. This is still insufficient to teach or suggest that the form information is stored within the *Lazzouni* system.

Third, the Examiner asserts that because the position information is determined based on the where the handwriting occurs on the encoded paper, that this teaches associating each of the handwritten annotations with a respective portion of the document information. This statement is wholly conclusory and is not supported by any teachings of *Lazzouni*. There is no teaching or suggestion that *Lazzouni* stores the form information within the system. As the form information is not stored, there can be no reasonable interpretation that the handwritten annotations are associated with any portion of the form information.

Fourth, the Examiner concludes that based upon certain teachings, the system **could** display the edited transaction to a user. However, as noted above, the fact that a system could do something is insufficient to establish inherency under 35 U.S.C. §102.³

Fifth, and finally, the Examiner again relies on what one skilled in the art would conclude. However, as the outstanding rejection is asserted under 35 U.S.C. §102, it is wholly improper for the Examiner to rely on what one skilled in the art would conclude.

For all of the reasons set forth above, Appellants maintain that *Lazzouni* fails to teach or suggest the elements as set forth in claim 10.

D. The Rejection Fails to Establish *Prima Facie* Anticipation of Independent Claim 16.

In response to Appellants' arguments that *Lazzouni* fails to teach or suggest "means for storing a document," "means for transferring information from the document to a printing device capable of printing the information on a surface provided with a position-coding pattern," "means for interpreting the editing information," and "means for changing the document information," the Examiner merely asserts that a computer system comprises various computer hardware and computer software that perform the functions as recited in the claim. However, this response fails to properly address Appellants' arguments.

Further, as *Lazzouni* fails to teach the functionality as recited, as noted above, Appellants maintain that the computer system of *Lazzouni*, to which the Examiner is relying upon to support his rejection, is insufficient to anticipate the means as recited in the claim. For the reasons set forth

³ See *Continental Can Co. USA, Inc. v. Monsanto*, 20 USPQ2d 1746, 1749, 1750 (Fed. Cir. 1991).

above and in Appellants' Appeal Brief, Appellants maintain that *Lazzouni* fails to anticipate all of the elements as recited in claim 16.

The Examiner further relies upon his arguments with regard to claim 1 to support his rejection of claim 16. However, for the reasons set forth above regarding claim 1 and for the reasons set forth in Appellants' Appeal Brief, *Lazzouni* fails to anticipate claim 16.

E. The Rejection Fails to Establish *Prima Facie* Anticipation of Independent Claim 22.

In response to Appellants' arguments that *Lazzouni* fails to teach or suggest "wherein the readable code comprises a grid and a plurality of symbols, the value of each symbol being determined by a displacement of a marking in relation to the grid," the Examiner responds in the Examiner's Answer on page 60 starting on line 15 as follows:

Looking at Figure 2 of the present application, it appears that the recited "value" is simply the distance from the pen's path from the "symbols" of the encoded paper as the pen is moved on the paper. That is, the pen's displacement from the nearby "symbols" (i.e., the value of each symbol") is measured as the pen is moved on the encoded paper in order to determine the location of the pen's path with respect to the "symbols." This closely corresponds with the examiner's interpretation that was previously set forth.

The information recording system in *Lazzouni* uses a plurality of the pixels to determine the coordinates of the pen as it is moved by the user. That is, as the user writes on the encoded paper, the pen moves over and between a plurality of pixels. These pixels are used to code the positions of the pen as it is moved by the user. This processing includes determining Δ values from the pixels as the pen moves on the encoded paper...

Appellants respectfully submit that the Examiner's interpretation is wholly inconsistent with the claim language.

The claim clearly recites "wherein the readable code comprises a grid and a plurality of symbols, the value of each symbol being determined by a displacement of a marking in relation to the grid." It is the readable code that includes a grid and symbols where each symbol has a value

and the value is determined by a displacement of a marking in relation to the grid. As such, the Examiner's interpretation of the value being based on the pen's position is wholly inconsistent with the claim language. The Examiner misinterprets the marking 7 as a pen point's position on the paper. Marking 7 of the Appellants' specification is clearly described in at least paragraph 25 of Appellants' specification and cannot be reasonably interpreted as a pen's path or the pen point's position on the paper.

Using the Examiner's own interpretation of the claim, *arguendo*, the pixel of *Lazzouni* anticipates the symbol of the present invention, while the pixel has a "value", i.e., the position of the pixel, this "value" is not determined based upon any displacement of any marking in relation to the grid, as required by the claim. In addition, as argued in Appellants' Appeal Brief, position in *Lazzouni* is determined by ordering horizontal and vertical data lines, not by determining displacement of any marking in relation to a grid.

Still further, the Examiner asserts in response to Appellants' arguments "[t]hese pixels are used to code the positions of the pen as it is moved by the user." This statement is a complete misinterpretation of *Lazzouni*. Each pixel of *Lazzouni* encodes one absolute position; the pixel is not "used to code the position of the pen as it is moved by the user." The pen of *Lazzouni* uses the pixels to determine its own position.

Finally, in the Examiner's Answer on page 63, in the last paragraph, the Examiner asserts that Appellants admitted certain teachings of *Henderson* (U.S. Patent No. 5,897,648) as prior art. However, Appellants note that the outstanding rejection of claim 22 is made under 35 U.S.C. §102. As noted above, in order to establish anticipation, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference, namely the cited reference of *Lazzouni*. If the Examiner is relying on the teachings of *Henderson* to

anticipate claim 22, the Examiner must establish *prima facie* obviousness under 35 U.S.C. §103. As the Examiner has rejected claim 22 asserting anticipation, the Examiner must find all of the claim elements within the cited art, *Lazzouni*. The Examiner's reliance on any teachings of *Henderson* is wholly improper in an analysis of anticipation under 35 U.S.C. §102.

For all of the reasons set forth above, Appellants maintain that as *Lazzouni* fails to teach or suggest all of the claim elements, the Examiner has failed to establish *prima facie* anticipation.

F. The Rejection Fails to Establish *Prima Facie* Anticipation of Dependent Claim 31.

Claim 31 depends directly from claim 22. Appellants submit that the rejection of claim 31 fails to establish *prima facie* anticipation for at least the reasons set forth above with regard to claim 22. Appellants further submit that dependent claim 31 is separately patentable and offer the following additional argument for the invention of claim 31.

The rejection of claim 31 asserts that *Lazzouni* teaches the incremental features recited therein. As the Examiner has failed to provide a reference that teaches or suggests all of the elements set forth in claim 22, in combination with the elements set forth in claim 31, and for the reasons set forth above with regard to claim 16, it is respectfully submitted that the Examiner has failed to establish *prima facie* anticipation. Thus, claim 31 is not anticipated by *Lazzouni*.

G. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 3.

In response to Appellants' arguments that neither of the references, either alone or in combination, teach or suggest receiving identity information from the reading device, the Examiner merely responds by asserting that *Henderson* teaches using different colors for edits made a

different locations. The Examiner additionally concludes in the Examiner's Answer starting on page 66 at line 17 as follows:

Based on these teachings, one of ordinary skill in the art at the time the invention was made ... would conclude that the pens used in the electronic document editing system in *Henderson* identifies an individual making a particular edit.

However, this teaching does not address Appellants' argument that neither reference teaches or suggests receiving identity information. Even if *Henderson* teaches, *arguendo*, distinguishing markings based on the pen that makes the marking, this is insufficient to teach receiving identity information where the identity information associates the editing information with a user of the reading device. In addition, the Examiner's purported conclusion about what one skilled in the art would conclude fails to rise to the level of teaching the claim element of "receiving device identity information from the reading device, the identity information associating the editing information with a user of the reading device," as required by the claim.

The Examiner further, again, misinterprets the teachings of the cited art. *Henderson*, at col. 12, lines 11-17 recites:

Various types of editing inputs may therefore be used at one location with at least one digitizer pen. Furthermore, for applications such as teleconferencing, operators at various remote locations can make edits that are identifiable with a given location or person. For example, editors at one location may use one color while editors at another location may use a different color. In this manner, the editing inputs from various persons and/or locations can be determined.

In other words, *Henderson* clearly teaches that the user may be identified only by their location, not by any identity information that is received where the identity information associates the editing information with the user. The color of the edits is only based on location. This is evidenced by the example given in the above citation.

As such, the Examiner's conclusion that one skilled in the art would conclude that pens used in the *Henderson* system identify an individual is wholly unsupported by the teachings of *Henderson*.

In addition, the Examiner maintains that one skilled in the art would have been motivated to modify *Lazzouni* for the purpose of allowing multiple editors to edit a common document and separately identifying a particular edit made by an individual. However, the system of *Lazzouni* does not store document information that includes original text (form information) and handwritten information, and, further, does not provide for access to the purported document having handwritten information for additional edits by another user.

Further, *Lazzouni* would appear to teach away from such a combination as the system seeks to store records of sales transactions. One skilled in the art would not look to modify *Lazzouni* to provide access to previously stored sales transactions for security purposes and to preserve the accuracy of the information related to the sales transactions.

For the reasons set forth above, and for the reasons set forth in Appellants' Appeal Brief, Appellants maintain that the Examiner has failed to establish *prima facie* obviousness by failing to provide references that teach or suggest all of the claim elements and by failing to provide proper motivation for such a combination.

H. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 2.

1. *Lazzouni* fails to teach or suggest "initially registering said document in a pattern administration unit," as required by claim 2

The Examiner asserts on page 24 of the Examiner's Answer that *Lazzouni* discloses:

The information recording system records different patterns of pixels for different documents. The patterns for the documents are unique in that each pattern is established by a

coding algorithm that includes the following factors: number of different inks used, number of shades (or intensity levels), number of data lines in each pixel, width of each line; dimensions of each pixel, size of the paper, and the number of pixels in the X and Y directions. The system stores these different patterns when they are created. Thus the system includes a "pattern administration unit" that "initially registers a document" in that the system creates a pattern of pixels for a document and stores that pattern of pixels. (see Figures 4 and 5; see Column 6, Line 35 through Column 8, Line 21)

Appellants disagree that *Lazzouni* discloses that the information recording system records different patterns of pixels for different documents. *Lazzouni* merely discloses that different patterns may be generated. There simply is no disclosure that indicates that the system records different patterns of pixels for different documents.

Appellants further disagree that *Lazzouni* discloses that the system stores these different patterns when they are created. The only information that *Lazzouni* teaches as being stored is coordinate information that is representative of the pen's position on the coded paper. There is simply no disclosure that teaches or suggests that the system stores the different patterns when they are created. As *Lazzouni* teaches that the coded paper is preferably printed by offset printing, this, in fact, suggests, that the code is not in electronic form stored within the *Lazzouni* system. Further, it is not inherent that the pattern itself is stored. Based on the teachings of *Lazzouni* the pen merely utilizes an algorithm to analyze the code on the paper to determine position. As such, the Examiner's conclusion that *Lazzouni* discloses initially registering the document in a pattern administration unit by teaching a system that creates a pattern of pixels for a document and stores that pattern of pixels is a complete misrepresentation of the teachings of *Lazzouni*

In response to Appellants' arguments that *Lazzouni* fails to teach or suggest "initially registering the document in a pattern administration unit," the Examiner responds in his Examiner's Answer on page 70, starting at line 17 as follows:

Lazzouni also expressly discloses that the encoded paper of the information recording system is used by sales/mobile personnel to record “business transactions” in “sales books” and can be “made as a form” (emphasis added) (see Column 4, Lines 43-50). Finally, Lazzouni also expressly discloses that, after the user has made entries into the form, the information recording system provides both a hardcopy and a digital copy of the edited form. (see Column 14, Lines 22-33).

Appellants respectfully disagree with the Examiner’s characterization of *Lazzouni*. *Lazzouni* discloses at col. 14, lines 22-33 as follows:

Another application of the present invention is in a sales book. Entries made by a salesman for each business transaction are stored in the memory and can be accessed by a host computer at the end of the day or the end of the week for further processing. The sales book can be used in the field or in a retail store. The information recording apparatus of the present invention provides a written copy of the sales transaction on paper and a record in memory. Other forms that can be configured in accordance with the present invention include bank checks, legal forms, credit application, bank forms and other forms requiring a record of a transaction.

As can be clearly seen from the above disclosure, there is no disclosure that is directed to the information recording system providing both a hardcopy and a digital copy of the edited form. *Lazzouni* merely teaches that the information recording apparatus provides a record of the handwritten information in memory.

The Examiner further argues in the Examiner’s Answer starting on page 71, line 1 as follows:

Based on these express disclosures, one of ordinary skill in the art at the time the invention was made ... would conclude that the form (i.e., “document”) was stored (i.e., registered”) in a database management component (i.e., “pattern administration unit”) that assigned a corresponding pixel pattern (i.e., “position-coding pattern”) to the form for the purpose of tracking and recording any entries, and the locations of those entries, entered into the form by the user.

Stated differently, the computerized information recording system in *Lazzouni* stores the form and the corresponding pixel pattern in order to track and record the entries and the locations of those entries, made to the form by the user.

Accordingly, *Lazzouni* discloses “initially registering said document in a pattern administration unit,” as recited in Claim 2.

Appellants respectfully disagree with the Examiner’s assertions.

As Appellants noted above, although *Lazzouni* discloses that the encoded paper may be made as a form, this teaching is insufficient to teach or suggest that the form is printed. Even if the form is printed, it is likely that the form is printed by a system that is not communicably linked to the *Lazzouni* system.

Still further, even though the *Lazzouni* system is capable of discerning positions as the pen moves across the surface of the paper, this does not mean that the pattern is stored within the *Lazzouni* system, or that the pattern is even needed to discern position. Based on the teachings of *Lazzouni*, the only information that is needed to determine position is an algorithm to order the horizontal and vertical data lines.

Lazzouni additionally teaches that the preferred method of printing the encoded paper is using offset printing. However, there is no teaching or suggest that the pattern is electronically stored within the *Lazzouni* system.

For all of the reasons set forth above, Appellants maintain that there is no teaching or suggestion in *Lazzouni* that is directed to a pattern administration unit. Further there is no teaching or suggestion in *Lazzouni* that is directed to initially registering the document in a pattern administration unit. As none of the other cited references teach or suggest this claim element, Appellants respectfully submit that the Examiner has failed to establish *prima facie* obviousness by failing to teach or suggest all of the claim elements.

2. **There is no teaching or suggestion in *Lazzouni* that is directed to “the pattern administration unit assigning a unique subset of said position-coding pattern to each page of said registered document,” as required by claim 2.**

The Examiner now asserts, on page 24 of the Examiner’s Answer, that *Lazzouni* teaches “the pattern administration unit assigning a unique subset of said position-coding pattern to the pages of said registered document,” by purportedly teaching:

The information recording system records the pattern of pixels to be used for the document in that the pixel patterns are prerecorded. Each page of the document will have the same pattern of pixels. (see Figures 4 and 5; see Column 6, Line 35 through Column 8, Line 21)

Appellants respectfully disagree with the Examiner’s assertions.

Lazzouni merely discloses creating a whole pattern based on certain parameters, i.e., size of paper. There is no teaching or suggestion whatsoever that is directed to assigning a unique subset of the position coding pattern to the pages of a registered document. *Lazzouni* does not store the position coding pattern, does not register a document in a pattern administration unit, and further does not assign a unique subset of the pattern to any registered document.

The Examiner asserts in response to Appellants’ argument that there is no teaching or suggestion that directed to the pattern administration unit assigning a unique subset of said position-coding pattern to each page of said registered document in his Examiner’s Answer starting on page 72, line 4 as follows:

Regarding Appellant’s argument that there is no disclosure in *Lazzouni* that is directed to any “pattern administration unit,” the examiner has already demonstrated that *Lazzouni* discloses a pattern administration unit,” as indicated in the “Response to Arguments” section that is directly above this section.

Appellants respectfully submit that this statement fails to address Appellants' arguments set forth in their Appeal Brief. Appellants maintain that *Lazzouni* fails to disclose that the coding pattern is electronically stored within the *Lazzouni* system.

As *Lazzouni* fails to teach or suggest his claim element, and as none of the other cited references teach or suggest this claim element, either alone or in combination, Appellants respectfully submit that the Examiner has failed to establish *prima facie* obviousness by failing to provide references that teach or suggest all of the claim elements.

3. *Lazzouni* fails to teach or suggest “transferring information indicative of the unique subset of the position coding pattern, assigned by the pattern-administration unit, to a printing device adapted to print the position-coding pattern on a surface,” as required by claim 2.

In response to Appellants' arguments, the Examiner asserts, on page 72, starting on line 22, in the Examiner's Answer as follows:

Lazzouni expressly discloses that the encoded paper of the information recording system includes prerecorded patterns of pixels that contain encoded position information (emphasis added)(see Column 6, Lines 35-37). Lazzouni also expressly discloses that the pixels of the pixel patterns are printed onto the paper according to coding algorithms (see Figures 4 and 5A-D; see Column 6, Line 61 through Column 7, Line 40).

According Lazzouni discloses printing patterns of pixels on paper.

In regard to Appellant's argument that Lazzouni is silent on the pattern administration unit assigning the unique subset of the position-coding pattern, Lazzouni expressly discloses that the uniqueness of the pixels in the patterns are established by coding algorithms (see Column 6, Lines 63-65).

Accordingly, Lazzouni discloses transferring an assigned subset to a printing device.

Appellants respectfully submit that even through, *arguendo*, *Lazzouni* may disclose creating different coding patterns using different coding algorithms, this teaching is insufficient to teach or suggest assigning a unique subset of a coding pattern to a registered document. Further, as noted above, *Lazzouni* discloses printing the encoded paper using offset printing. As such, the Examiner's

interpretation of this disclosure to teach “transferring information indicative of the unique subset of the position coding pattern to a printing device” is wholly improper.

For the reasons set forth above, and for the reasons set forth in Appellants’ Appeal Brief, Appellants maintain the Examiner has failed to establish *prima facie* obviousness.

I. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 17.

In response to Appellants’ arguments regarding claim 17, the Examiner provides comments similar to those provided in response to claim 2. However, for the reasons set forth above, and for the reasons set forth in Appellants’ Appeal Brief, Appellants maintain that the Examiner has failed to establish *prima facie* obviousness by failing to provide references that teach or suggest all of the claim elements.

IV. CONCLUSION

For all the reasons set forth above, the rejections in the Examiner's Answer dated November 24, 2006, are improper. It is therefore respectfully requested that the Examiner be reversed on all grounds.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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